

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY E. FOWLER
and STEVE P. PHIFER

Appeal No. 1999-2530
Application 08/882,809

ON BRIEF

Before GARRIS, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain either of the rejections of appealed claims 1 through 20,¹ under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

¹ See the amendment of May 18, 1998 (Paper No. 5). Claim 21, also of record, stands withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

claim the subject matter which applicants regard as the invention, and under 35 U.S.C. § 103 as being unpatentable over Burton et al. (Burton) in view of White et al. (White).²

The ground of rejection under § 112, second paragraph, is explained with respect to only claims 9 through 16 even though stated to include all of the appealed claims (answer, pages 3-4). The examiner holds the rejection to include claim 1, apparently because claims 9 through 16 depended directly or ultimately thereon, as well as claims 2 through 8 and 17 through 20 because they “depend from claim 1 in some manner” (*id.*, page 6) and then states that the rejection is moot with respect to claims 17 through 20 (*id.*, page 7). In any event, the examiner’s contention with respect to claims 9 through 16 is that “it is unclear if ‘a second epoxy[.]’ (see line 4) and ‘a second epoxy resin’ (see line 9) are the same” (*id.*). In making out a *prima facie* case of non-compliance with this statutory provision³ on the basis that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention, the examiner must establish that when the language of the appealed claims is considered as a whole as well as in view of the specification as it would be interpreted by one of ordinary skill in the art, the claims in fact fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). We find ourselves in agreement with appellants, that when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), the plain language of appealed claim 1 clearly specifies that there are two separate additions of epoxy resin, the first, that is, “a first . . . epoxy resin,” in step (b), and a second, that is, “a second epoxy resin,” in step (c). The same interpretation holds for claims 2 through 8. Thus, claims 9 through 16, which sequentially depend on claims 1 through 8, certainly comply with the requirements of this statutory provision and, therefore, we reverse this ground of rejection.

² Answer, pages 3-6.

³ The initial burden of establishing a *prima facie* case on any ground under the second paragraph of § 112 rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), *citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”).

Turning now to the ground of rejection under § 103, it is well settled that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant’s disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *Oetiker, supra*; *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

We further agree with appellants that when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, the plain language of appealed claim 1 further requires in step (b) that the mixture is a viscous, thermoplastic epoxy resin, which is the “first” resin, and a catalyst, wherein the first resin is non-reactive with the catalyst and the catalyst is present in an amount which catalyzes the reaction of the first resin as well as the “second” resin and polycyanate cross-linking agent which are added as a mixture in step (d). We still further agree with appellants that the process of Burton requires a *first* mixture which includes a first epoxy resin, a *curing agent* therefor and *no effective amount of catalyst*, and a *second* mixture which includes a second epoxy resin, a *curing agent* therefor and *catalyst* (e.g., col. 1, lines 47-67; col. 2, lines 58-61, col. 3, lines 51-53 and 61-64). The differences between these two mixtures of Burton and the two mixtures of appealed claim 1 are manifest from mere comparison. We find that the examiner has not explained why one of ordinary skill in this art would have found in Burton or in the combined teachings of Burton and White any suggestion to modify the two mixtures of Burton so as to arrive at the two mixtures of the claimed process, and upon carefully considering these references, separately and combined, we fail to find any

such suggestion. Accordingly, the examiner has failed to make out a *prima facie* case of obviousness and, therefore, we reverse.

The examiner's decision is reversed.

Reversed

BRADLEY R. GARRIS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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